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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,118	04/12/2001	Craig A. Rosen	6832.0017	6475

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,118

Applicant(s)

ROSEN ET AL.

Examiner

Hope A. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 22-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election with traverse of Group I (claims 1-21) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the claims not be restricted because no serious burden exists. Applicant states that search and examination of the subject matter of Group I would encompass a search for the subject matter of Group II and IV and any additional search would not impose a serious burden upon the examiner. This statement made by applicant appears to be contradictory as it is first stated that no additional search would be required and then concluded that any additional search would not be a burden. This argument is also not persuasive because the MPEP states that restriction requirement is proper if the inventions are independent or distinct. Applicant is not disputing the fact that the invention is independent or distinct, only that there is no search burden. MPEP 806.04 states that "if it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. Additionally, note that the inventions have acquired a separate status in the art, which demonstrates burden of search. Thus, the restriction requirement is proper and final.

Oath/Declaration

2. The Oath/Declaration is objected to because there appears to a stray mark that is not initialed or dated for inventor William Haseltine. See MPEP § 608.01(b).

Correction is required.

Basis For Statutory Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 09/833,111. The claims in both applications have the same language, scope, wording and subject matter. Both applications claim an albumin fusion protein comprising a therapeutic protein: X and albumin comprising the amino acid sequence of SEQ ID NO: 18. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 09/833,118. The claims in both applications have the same language, scope, wording and subject matter. Both applications claim an albumin fusion protein comprising a therapeutic protein: X and

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albumin comprising the amino acid sequence of SEQ ID NO: 18. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 09/832,929. The claims in both applications have the same language, scope, wording and subject matter. Both applications claim an albumin fusion protein comprising a therapeutic protein: X and albumin comprising the amino acid sequence of SEQ ID NO: 18. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 09/832,501. The claims in both applications have the same language, scope, wording and subject matter. Both applications claim an albumin fusion protein comprising a therapeutic protein: X and albumin comprising the amino acid sequence of SEQ ID NO: 18. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

8. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 09/833,111. The claims in both applications have the same language, scope, wording and subject matter. Both applications claim an albumin fusion protein comprising a therapeutic protein: X and albumin comprising the amino acid sequence of SEQ ID NO: 18. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. Claims 1-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 09/833,117. The claims in

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both applications have the same language, scope, wording and subject matter. Both applications claim an albumin fusion protein comprising a therapeutic protein: X and albumin comprising the amino acid sequence of SEQ ID NO: 18. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5-10, 13-14 and 17-21 are rejected under 35 U.S.C. 102 (b) as being anticipated by DELTA BIOTECHNOLOGY LTD. (WO 97/24445, July 10, 1997 or KR99076789, October 15, 1999).

DELTA BIOTECHNOLOGY LTD. disclose serum albumin fusion proteins comprising the sequence set forth in SEQ ID NO: 18 of the instant application with a 100% sequence identity (claim 1, see the sequence alignment and page 1 of the reference). Additionally, the reference discloses that the albumin is useful as a component of a fusion protein because it is a stabilizer and transporter of other proteins (page 1) and that the fusion proteins have an increased circulatory half-life (shelf-life) over unfused proteins (claim 2, page 3). The fusion protein of the claimed invention comprises "therapeutic protein X and albumin and the disclosure on page 2 indicates

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that the therapeutic protein is a polypeptide, antibody, peptide, fragments or variants thereof. As the reference discloses the fusion of albumin with a growth hormone described as a single polypeptide (page 2), by definition in the instant application the growth hormone fusion partner is a therapeutic protein. DELTA BIOTECHNOLOGY LTD. discloses that the half-life (shelf-life) of the fusion protein is greater than the half-life of fusion partner by itself. Additionally, the reference teaches that activity assays showed that the conjugate retained full, and possibly increased activity *in vitro* ((claim 3, page 3). It is disclosed that fusion to the polypeptide is achieved by genetic manipulation such that the DNA coding for HSA or a fragment thereof is joined to the DNA coding for said polypeptide (claim 5 and page 2 of the instant specification, page 1 of the reference). The reference discloses fragments/variants thereof of SEQ ID NO: 18 (claim 6, page 3). Further, as claim 6 recites the open language of comprising and the reference discloses the entire sequence set forth in SEQ ID NO: 18, the claimed fragments are anticipated. Regarding claims 7, 8, 9 and 10 which depend from claims 5 and 6, however encompass the limitation that a portion of albumin is sufficient to prolong the shelf-life (half-life), these claims are also anticipated by the reference which discloses the limitation of claims 5 and 6 and teach biologically active fragments of albumin having the activity of increasing the half-live (page 3).

DELTA BIOTECHNOLOGY LTD. discloses fusion proteins that are non-glycosylated (claim 13, page 2). The reference also discloses expression in *S. cerevisiae* (yeast) as recited in claim 14 (pages 2, 4). It is also stated that expression can occur in animal cells in culture (claims 17-18, page 8). The reference discloses a leader sequence (claim 19, page 17). A composition comprising the albumin fusion protein coupled with an acceptable carrier is disclosed (claim 20, page 12). Regarding claim 21 and the recitation of a kit comprising the composition, the reference teaches a

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pharmaceutical formulation comprising the fusion protein with one or more acceptable carrier presented in a unit dosage form which is equivalent to a kit (page 12).

Therefore, as the structure of the protein in the reference is identical to that of the instant application and the reference discloses albumin fusion proteins and fragments thereof with increased albumin activity, the limitations of the claims are met by this reference.

Conclusion

11. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low, can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

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Hope Robinson, MS~~HA~~

Patent Examiner

Christopher S. F. Low

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